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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/241,083 02/01/99 KOSUDA

H 1080.1071/JD

EXAMINER

LMC1/0927

STAAS & HALSEY
700 ELEVENTH STREET N W
SUITE 500
WASHINGTON DC 20001

RETTA, Y

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

09/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/241,083

Applicant(s)

Kosuda et al.

Examiner

Yehdega Retta

Group Art Unit

2764



☒ Responsive to communication(s) filed on Jul 18, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Amendment

1. This office action is in response to amendment filed 7/18/00. Claims 1-6 have been amended and claims 7-9 have been added.

Response to Arguments

2. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: page 21 of the specification mentions screen 86 which is not included in the drawing. Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Regarding claims 1 and 7-9, the claims recite “providing options to the customer to choose from....., and both transmit the receipt to the destination and print it at said facility”.

The specification does not disclose providing options to the customer to transmit the receipt to the destination address and print it at the facility. The specification shows providing option to the customer to transmit the receipt to the destination address or to print it at the facility.

7. Claims 2-6 are rejected as being dependent on rejected claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tognazzini U.S. Patent No. 5739512.

10. As per claim 1, Tognazzini disclose a display device; means for controlling the display; performing input operation in accordance with a display on the device (see col. 5 lines 17-28 and fig. 2), performing on the display device a screen display in which a destination electronic mail

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address for receiving a transaction record is able to be input through the input means and a screen display providing options to the consumer to choose from, the options being to transmit the transaction record to the destination address or print the transaction record at the facility (see col. 6 lines 17-25 and fig. 5).

11. Regarding claims 7-9, Tognazzini teaches a display device and an input device enabling the customer to perform transaction according to options displayed on the display device and a transaction receipt process displaying options on said display device. The claim recites displaying options to receive..... It does not recites transaction receipt being receive at the destination electronic mail address or received as paper receipt or both. The recited statement of intended use, to receive transaction record, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide option to make any selection in the system taught by Tognazzini because the subjective interpretation of the displaying option to selectively receive does not patentably distinguish the claimed invention.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini U.S. Patent No. 5739512.

14. As per claims 2, 5 and 6, Tognazzini teaches display control means perform on the display device a screen display in which a record being able to be input (see fig. 2). Tognazzini does not teach a number of transaction records is able to be input. The claim does not recite any action or step performed after the number is input which distinguish the claimed invention from the prior art in terms of patentability. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to input any data in the display as shown in Tognazzini because inputting different data from the prior art would have been obvious matter of design choice.

15. As per claims 3 and 4, Tognazzini teaches a display device; display control means; input means for performing an input operation in accordance with a display and control means for communicating with the host computer (see fig. 1); displaying transaction indications including a payment indication, and performs on said display device a screen display indicative of an electronic mail address for transmitting a transaction record is able to be registered, transmitting the input electronic mail address via communication line to host computer so that the electronic mail address is registered in association with transaction information file for customers (see col.

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6 lines 26-39 and fig. 4). Tognazzini does not specifically teach performing a screen display in which it is selectable through the input means as to whether the transaction record....when a selection operation that the transaction record is to be transmitted to an electronic mail address....performing a screen display in which a new destination electronic mail address ...is able to input. Tognazzini teaches performing a screen display in which it is selectable through input means and performing a screen display in which E-mail address is input (see col. 5 lines 1-45). The claim does not recite any action performed by the system after selection is made through the input means which distinguish the claimed invention from the prior art in terms of patentability . Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to make selection through the input means in the screen display as shown in Tognazzini because making selection different from the prior art would have been obvious matter of design choice.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goldsmith U.S. Patent No. 6064990, system for electronic notification of account activity.

Marshall; Internet banking: How far, how fast?; US Banker, v108, n3, p66-68, Mar 1998.

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View Source Magazine; Reliable Sources; All the News That's Bits. March 10, 1997;
http://developer.netscape.com/viewsource/news3_10.htm.

VOCM: Leaders in Web Banking; Welcome to VOCM; <http://www.vocomic.com>.

Web@TM - XYZ Bank; Welcome to the VCOM Internet Banking Demo;
https://emerald.vocomic.com_webatm.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on Monday-Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 308-5397, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner
Yehdega Retta
Art Unit 2764
September 23, 2000


James P. Trammell
Supervisory Patent Examiner
Technology Center 2700